

Appl. No. 09/893,734
Reply to Office Action of November 7, 2003 (Paper No. 10)

Remarks

Claims 38-46 stand in the application. Claims 30-37 have been cancelled without prejudice to the underlying subject matter. Claims 45 and 46 have been amended. Reconsideration and allowance of the standing claims are respectfully requested.

Claims 30-39, 41, 42, and 44-46 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Number (USPN) 5,872,841 (King). Applicant respectfully requests reconsideration and removal of this rejection.

Claims 38-39, 41, 42 and 44-46 define over King. Claims 38-39, 41, 42 and 44-46 each recite setting a date and time for an event reminder for an event by a first person for a second person. King discloses a system to schedule a telephone call between two parties. The parties may be notified of the scheduled telephone call by email or voice mail. King, Col. 6: Lines 55-60. King fails to discuss, however, setting a reminder for either party of the scheduled telephone call. Further, King fails to discuss setting a date and time for an event reminder. In addition, King fails to discuss one party setting an event reminder for another party. Consequently, claims 38-39, 41, 42 and 44-46 represent patentable subject matter over King. Accordingly, removal of the rejection for claims 38-39, 41, 42 and 44-46 is respectfully requested.

Claims 40 and 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of USPN 6,088,429 (Garcia). Applicant respectfully traverses this rejection.

Claims 40 and 43 define over King in view of Garcia. Claims 40 and 43 both recite the feature discussed with reference to claims 38-39, 41, 42 and 44-46. King fails

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to disclose this feature as discussed above. Garcia also fails to disclose this feature, as well as others.

Garcia fails to disclose setting a date and time for an event reminder for an event by a first person for a second person as recited by the claimed subject matter. Garcia is directed to an interactive telephony system for medication data systems. The Garcia system may call a patient when a patient's profile is updated with information. An example of an update may be "the approach of an impending appointment of the patient." Garcia, Col. 5: Lines 2-3. The update is given according to two alternative set of operations. The first set of operations waits a predetermined amount of time T1 before calling the patient. The second set of operations skips T1 and calls the patient immediately after the profile has been updated. Garcia, Col. 5: Lines 5-42. In either case, a person does not set a date and time to call the patient. Although T1 may be adjustable, there is no mention of T1 being adjustable by one person for another person, such as a caller for a patient. Rather, the adjustment of T1 is presented as a system parameter set at the initial configuration of the system, since the adjustment of T1 is shown as an embodiment variation for different implementations of the Garcia system. See Garcia, Col. 5: Lines 36-42.

In addition, Garcia fails to disclose confirmations as recited by the claimed subject matter. Claims 40 and 43 both recite the features of requesting confirmation as to whether the second person is to attend the event, receiving confirmation from the second person, and sending the confirmation to the first person. The Garcia system delivers a general message (M2) rather than a reminder message (M1) to the patient due to confidentiality issues associated with the medical field. Garcia, Col. 5: Lines 29-35.

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Thus, the Garcia system expects the patient to call the interactive system to receive the reminder message (M1). The Garcia system does state that the reminder message (M1) may be retrieved by the patient once authenticated. This feature, however, absolutely requires the patient to perform additional operations, thereby decreasing the convenience of the system. By way of contrast, claims 38-46 do not recite any such authentication operations.

The Office Action has also failed to meet its burden of establishing a *prima facie* case of obviousness. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness since there is no suggestion or motivation to combine King and Garcia in an attempt to arrive at the claimed invention. The Office Action states that it would be obvious to combine King with Garcia since the "modification would allow a first person to view the result of a scheduled event as suggested by both Garcia and King." Office Action, Page 4. Applicant respectfully submits that this suggestion is disclosed by the instant application, and is applied in hindsight to the references. King fails to describe

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event reminders in any context, let alone that of the claimed subject matter. Therefore, it would follow a fortiori that King fails to provide the requisite suggestion or motivation. Garcia discusses sending pre-set reminders exclusively for authenticated patients in the narrow field of medical applications, which have a host of privacy requirements that may be incompatible or inconsistent with the system disclosed by King. Consequently, Garcia would have no need to suggest or motivate a combination with King.

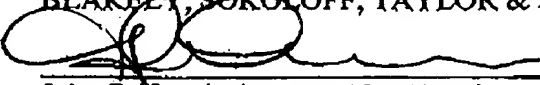
For at least the reasons given above, Applicant submits that claims 40 and 43 recite patentable subject matter over King in view of Garcia. Removal of this rejection for claims 40 and 43 is therefore respectfully requested.

It is believed that claims 38-46 are in allowable form. Accordingly, a Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,
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John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

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